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PATENT APPLICATION

ATTORNEY DOCKET NO. 10003829-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): David S. HAINING

Confirmation No.: 1239

Application No.: 09/838,981

Examiner: Gibbs, Heather

Filing Date: April 20, 2001

Group Art Unit: 2627

Title: PORTABLE PHOTO SCANNER WITH TASK ASSIGNER

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on December 22, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

(a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

1st Month
\$120

2nd Month
\$450

3rd Month
\$1020

4th Month
\$1590

The extension fee has already been filed in this application.

(b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

David S. HAINING

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

Applicant:

David S. HAINING

Confirmation No.: 1239

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Title:

PORTABLE PHOTO SCANNER WITH TASK ASSIGNER

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2627

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Gibbs, Heather D.

Docket No.:

10003829-1

MAIL STOP: APPEAL BRIEF PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Dear Sir:

APPEAL BRIEF

Applicant has appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed November 2, 2005, finally rejecting Claims 1-16. Applicant filed a Notice of Appeal on December 22, 2005. Applicants respectfully submits herewith this Appeal Brief with authorization to charge the statutory fee of \$500.00.

REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1-16 stand rejected pursuant to a Final Office Action mailed November 2, 2005. Claims 1-16 are presented for appeal.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to the mailing of the Final Office Action.

SUMMARY OF CLAIMED SUBJECT MATTER

Embodiments of the present invention as defined by independent Claim 1 are directed toward a portable picture storage device (10, 600) comprising an input (11, 601) for receiving a plurality of pictures, a storage area for storing the plurality of pictures, and a plurality of user interface indicators (12, 13, 14, 602, 700, 701, 702, 703, 704), wherein each indicator (12, 13, 14, 602, 700, 701, 702, 703, 704) is associated with a respective meta data of a plurality of meta data, and each meta data indicates at least one disposition of a plurality of dispositions, and wherein at least one picture of the plurality of pictures, via activation of an indicator (12, 13, 14, 602, 700, 701, 702, 703, 704), is associated with

a meta data and thereby at least one disposition. (at least at page 7, lines 1-12 and 16-29; page 8, lines 1-14; page 9, lines 8-28; page 11, lines 19-29; and figures 1-3 and 6).

Embodiments of the present invention as defined by independent Claim 7 are directed toward a system (10, 600) for managing disposition of a plurality of pictures comprising an input means (11, 601) for receiving a plurality of pictures, a storage means for storing the plurality of pictures, and means for indicating (12, 13, 14, 602, 700, 701, 702, 703, 704) at least one disposition of a plurality of dispositions, the means for indicating (12, 13, 14, 602, 700, 701, 702, 703, 704) associated with a meta data for indicating the at least one disposition, and wherein at least one picture of the plurality of pictures, via the means for indicating (12, 13, 14, 602, 700, 701, 702, 703, 704), is associated with said at least one disposition of the plurality of dispositions by associating the meta data with the at least one picture. (at least at page 7, lines 1-12 and 16-29; page 8, lines 1-14; page 9, lines 8-28; page 11, lines 19-29; and figures 1-3 and 6).

Embodiments of the present invention as defined by independent Claim 13 are directed toward a method for managing disposition of a plurality of pictures comprising receiving a plurality of pictures, storing the plurality of pictures, and associating an indication of at least one disposition of a plurality of dispositions with at least one picture of the plurality of pictures, the indication comprising meta data indicating the at least one disposition. (at least at page 7, lines 1-12 and 16-29; page 8, lines 1-14; page 9, lines 8-28; page 11, lines 19-29; and figures 1-3 and 6).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-2, 6-8, 12-14 and 16 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,658,202 issued to Battaglia et al. (hereinafter “*Battaglia*”).

2. Claims 3, 9 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable in view of *Battaglia* in view of U.S. Patent No. 6,369,908 issued to Frey et al. (hereinafter “*Frey*”).

ARGUMENT

A. Standard

1. 35 U.S.C. § 102

Under 35 U.S.C. § 102, a claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claims” and “[t]he elements must be arranged as required by the claim.” *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131.

2. 35 U.S.C. § 103

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991); M.P.E.P. § 2143. Additionally, not only must there be a suggestion to combine the functional or operational aspects of the combined references, but also the prior art is required to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 F.2d 1173, 1183 (Fed. Cir. 1991).

B. Argument

1. First Ground of Rejection (Claims 1-2, 6-8 and 12)

Claims 1, 2, 6-8 and 12 are rejected under 35 U.S.C. §102(e) as being unpatentable in view of *Battaglia*. Of these claims, Claims 1 and 7 are independent. Applicant respectfully submits that each of independent Claims 1 and 7 are patentable

over the *Battaglia* reference and, therefore, Claims 2, 6, 8 and 12 that depend respectively therefrom are also patentable.

Embodiments of the present invention are directed toward a method and device (10, 600) for capturing and/or storing pictures and associating a particular disposition with the pictures such that the disposition can be carried out and/or executed when the pictures are downloaded to a computer (at least at page 5, lines 1-8, page 7, lines 22-29; page 11, lines 19-29; and figures 1-3 and 6). For example, in some embodiments of the present invention, the device (10, 600) comprises user interface indicators such as buttons (12, 13, 602, 700, 703, 704) and/or a touch screen (14, 701, 702) where each indicator is associated with a particular disposition (e.g., e-mail, store to disk, change size, paper print, etc.) (at least at page 5, lines 20-28). In some embodiments of the present invention, meta data is used to indicate a particular disposition for a picture, and particular user interface indicators are associated with particular meta data, thereby correlating the particular indicator with a particular disposition (at least at page 7, lines 22-29). Thus, in some embodiments of the present invention, the user interface indicator, when actuated, would mark and/or tag a particular picture with its associated meta data, thereby associating a particular disposition with the picture (at least at page 7, lines 22-29). Accordingly, Claim 1, for example, recites “an input for receiving a plurality of pictures,” “a storage area for storing the plurality of pictures,” “a plurality of user interface indicators, wherein each indicator is associated with a respective meta data of a plurality of meta data, and each meta data indicates at least one disposition of a plurality of dispositions” and “wherein at least one picture of the plurality of pictures, via activation of an indicator, is associated with a meta data and thereby at least one disposition.”

In the Final Office Action, the Examiner asserts that *Battaglia* discloses the limitations of Claim 1 (Final Office action, page 3). Applicant respectfully disagrees. *Battaglia* appears to disclose a mass storage device configured to receive a memory module (e.g., a flash memory module removed from a digital camera) (*Battaglia*,

column 2, lines 21-27, figure 1). *Battaglia* also appears to disclose that the mass storage device contains user interface keys 16 and 18 utilized by a user to initiate a download of information from the memory media to the mass storage device or to reformat the memory module (*Battaglia*, column 2, line 66 to column 3, line 5). For example, *Battaglia* recites:

At least one control key is provided for initiating the download operation. Another user interface key is used to reformat the memory module in accordance with its requirements for reuse in, for example, a digital camera for taking further photographs.

(*Battaglia*, column 3, lines 1-5). *Battaglia* further recites:

[T]he user interface keys 16, 18 comprise a portion of a miniaturized keyboard, which may, for example, be utilized to select particular files and directories to copy to the mass storage device 20 . . .

(*Battaglia*, column 3, lines 13-17). Thus, *Battaglia* does not appear to disclose or even suggest “a plurality of user interface indicators, wherein each indicator is associated with a respective meta data” where the “meta data indicates at least one disposition” for a picture as recited by Claim 1 (emphasis added). Further, *Battaglia* does not appear to disclose or even suggest “associat[ing] . . . meta data” with “at least one picture . . . via activation of an indicator” as recited by Claim 1. To the contrary, Applicant respectfully submits that pushing a button (e.g., buttons 16 or 18 of the *Battaglia* device) to select particular files is not equivalent to associating meta data with a picture where the meta data indicates the disposition of the picture as generally recited by Claim 1. Accordingly, for at least these reasons, Applicant respectfully submits that *Battaglia* does not anticipate Claim 1.

Further, in the Final Office Action, the Examiner appears to assert that the particular files and directories that are copied to a mass storage device in *Battaglia* are themselves the “meta data” recited by Claim 1 (“the user interface indicators 16, 18 . . . are associated with particular files and directories (meta data)” (Final Office Action,

page 2)). Applicant respectfully disagrees. *Battaglia* appears to disclose that such “files and directories” correspond to graphical images (*Battaglia*, column 3, lines 13-24). Thus, the Examiner appears to consider such “files and directories” to correspond to both the “pictures” and the “meta data” that is associated with the pictures as recited by Claim 1, which is an improper claim construction. Moreover, such “files and directories” do not appear to indicate any particular disposition, nor has the Examiner identified in *Battaglia* how such “files and directories” of *Battaglia*, themselves, indicate a disposition. To the contrary, Applicant respectfully submits that such teaching is absent from *Battaglia*. Therefore, for at least this reason also, Applicant respectfully submits that *Battaglia* does not anticipate Claim 1.

Independent Claim 7 recites “an input means for receiving a plurality of pictures,” “a storage means for storing the plurality of pictures,” “means for indicating at least one disposition of a plurality of dispositions, the means for indicating associated with a meta data for indicating the at least one disposition” and “wherein at least one picture of the plurality of pictures, via the means for indicating, is associated with said at least one disposition of the plurality of dispositions by associating the meta data with the at least one picture” (emphasis added). At least for the reasons discussed above in connection with independent Claim 1, Applicant respectfully submits that *Battaglia* also does not anticipate Claim 7.

Therefore, Claims 1 and 7 are clearly patentable over the *Battaglia* reference. Accordingly, Applicant respectfully submits that Claims 1 and 7, and Claims 2, 6, 8 and 12 that depend respectively therefrom, are allowable.

2. First Ground of Rejection (Claims 13, 14 and 16)

Claims 13, 14 and 16 are rejected under 35 U.S.C. §102(e) as being unpatentable in view of *Battaglia*. Of the rejected claims, Claim 13 is independent. Applicant respectfully submits that independent Claim 13 is patentable over the *Battaglia* reference and, therefore, Claims 14 and 16 that depend therefrom are also patentable.

Independent Claim 13 recites “receiving a plurality of pictures,” “storing the plurality of pictures” and “associating an indication of at least one disposition of a plurality of dispositions with at least one picture of the plurality of pictures, the indication comprising meta data indicating the at least one disposition” (emphasis added). As discussed above in connection with independent Claim 1, the Examiner appears to assert that the interface keys 16 and 18 of *Battaglia* are associated with meta data indicating a disposition of a picture (Final Office Action, page 3). Applicant respectfully disagrees. Applicant respectfully submits that pushing a button (e.g., buttons 16 or 18 of the *Battaglia* device) to select particular images is not equivalent to associating meta data with a picture where the meta data indicates the disposition of the picture as generally recited by Claim 13. Moreover, the Examiner appears to consider the selected “files and directories” of *Battaglia* to correspond to both the “pictures” and the “meta data” that is associated with the pictures as recited by Claim 13, which is an improper claim construction. Additionally, such “files and directories” of *Battaglia* do not appear to indicate any particular disposition, nor has the Examiner identified in *Battaglia* how such “files and directories” of *Battaglia*, themselves, indicate a disposition. To the contrary, Applicant respectfully submits that such teaching is absent from *Battaglia*. Therefore, for at least these reasons, Applicant respectfully submits that *Battaglia* does not anticipate Claim 13.

Therefore, Claim 13 is clearly patentable over the *Battaglia* reference. Accordingly, Applicant respectfully submits that Claim 13, and Claims 14 and 16 that depend therefrom, are allowable.

3. Second Ground of Rejection (Claims 3, 9 and 15)

Claims 3, 9 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable in view of *Battaglia* in view of *Frey*. Claims 3, 9 and 15 depend respectively from independent Claim 1, 7 and 13. As discussed above, Claims 1, 7 and 13 are patentable over the *Battaglia* reference. For example, *Battaglia* does not disclose or even suggest

associating meta data with a picture where the meta data indicates a disposition of the picture as generally recited by Claims 1, 7 and 13. Moreover, *Frey* does not appear to remedy, nor does the Examiner rely on *Frey* to remedy, at least the above-referenced deficiencies of *Battaglia*. Thus, for at least these reasons, Applicant respectfully submits that Claims 3, 9 and 15 are patentable.

CONCLUSION

Applicant has demonstrated that the present invention as claimed is clearly distinguishable over the art cited of record. Therefore, Applicant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Commissioner is authorized to charge the statutory fee of \$500.00 to Deposit Account No. 08-2025 of Hewlett-Packard Company. Although no other fee is believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,



James L. Baudino
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Date: February 15, 2006

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CLAIMS APPENDIX

1. A portable picture storage device comprising:
an input for receiving a plurality of pictures;
a storage area for storing the plurality of pictures; and
a plurality of user interface indicators, wherein each indicator is associated with a respective meta data of a plurality of meta data, and each meta data indicates at least one disposition of a plurality of dispositions;
wherein at least one picture of the plurality of pictures, via activation of an indicator, is associated with a meta data and thereby at least one disposition.

2. The portable picture storage device of claim 1 wherein:
the one picture is associated with the meta data during storage into the device.

3. The portable picture storage device of claim 1 wherein the at least one disposition is selected from the group consisting of:
printing, storing to another storage area, e-mailing to a recipient, image processing, and deleting.

4. The portable picture storage device of claim 1 wherein:
the device is a camera and the input is a lens imaging system.

5. The portable picture storage device of claim 1 wherein:
the device is a scanner and the input is a scanning mechanism.

6. The portable picture storage device of claim 1 wherein:
the device is coupled to a computer system, which receives the one picture, and processes the one picture according to the meta data associated with the one picture.

7. A system for managing disposition of a plurality of pictures, comprising:
an input means for receiving a plurality of pictures;
a storage means for storing the plurality of pictures; and
means for indicating at least one disposition of a plurality of dispositions, the
means for indicating associated with a meta data for indicating the at least one
disposition;

wherein at least one picture of the plurality of pictures, via the means for
indicating, is associated with said at least one disposition of the plurality of dispositions
by associating the meta data with the at least one picture.

8. The system of claim 7 wherein:
the one picture is associated with the at least one disposition during storage into
the device.

9. The system of claim 7 wherein the at least one disposition is selected from the
group consisting of:

printing, storing to another storage area, e-mailing to a recipient, image
processing, and deleting.

10. The system of claim 7 wherein: the system is a camera.

11. The system of claim 7 wherein: the system is a scanner.

12. The system of claim 7 further comprising:
coupling means for connecting the system to a computer, wherein the computer
includes means for receiving the one picture, and means for processing the one picture
according to the at least one disposition associated with the one picture.

13. A method for managing disposition of a plurality of pictures, comprising:
receiving a plurality of pictures;
storing the plurality of pictures; and
associating an indication of at least one disposition of a plurality of dispositions
with at least one picture of the plurality of pictures, the indication comprising meta data
indicating the at least one disposition.

14. The method of claim 13 wherein:
the step of associating is operative with the step of storing.

15. The method of claim 13 wherein the dispositions are selected from the group
consisting of:

printing, storing to another storage area, e-mailing to a recipient, image
processing, and deleting.

16. The method of claim 13 further comprising:
connecting the system to a computer;
receiving, by the computer, the one picture;
processing, by the computer, the one picture according to the at least one disposition
associated with the one picture.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None